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HAROLD B. WILLEY, C

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No. 580

WARNER BROS. PICTURES, INC. AND ALFRED A. KNOPF, INC.
Petitioners,

vs.

COLUMBIA BROADCASTING SYSTEM, INC.; WILLIAM SPIER; THE WILDROOT COMPANY, INC.; REGIS RADIO CORPORATION, WILLIAM ROBERT TALLMAN, GILES B. DOUD, JOE EISINGER, BATTEN, BARTON, DURSTINE & OSBORN, INC., AND DASHIELL HAMMETT,
Respondents.

PETITION OF WARNER BROS. PICTURES, INC., AND ALFRED A. KNOPF, INC. FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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Warner Bros. Pictures, Inc. and Alfred A. Knopf, Inc. pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit, entered in the above-entitled case on November 9, 1954.

Opinions Below

The opinion of the United States District Court for the Southern District of California, Central Division (R. 74) is reported at 102 Fed. Supp. 141, 92 U.S.P.Q. 54, 28 Copyright Office Bulletin 499. The opinion of the Court of

Appeals for the Ninth Circuit (R. 531) is reported at 216 F. 2d 945, 104 U.S.P.Q. 103, and is printed in Appendix B.

Jurisdiction

The judgment of the Court of Appeals for the Ninth Circuit, dated November 9, 1954 was entered on the same day. The jurisdiction of this Court is invoked under 28 U.S.C., Section 1254 (1).

Questions Presented

1. Are the distinctive and original fictional characters who are portrayed in a published and copyrighted work of fiction included in and protected by the statutory copyright which protects such work of fiction?

2. If the author of a published and copyrighted novel (The Maltese Falcon) portraying distinctive and original fictional characters (Sam Spade), first grants *exclusive* motion picture, television and radio rights under copyright in the novel, can he subsequently grant motion picture, television and radio rights in the *identical characters* to third parties?

3. In such case, is the broadcasting by the third parties of a radio series portraying such characters an infringement of the rights in the copyright first granted by the author?

4. In such case, do these broadcasts unfairly compete with the rights in the copyright granted by the author?

Statutes Involved

The Copyright Act, Act of July 30, 1947, c. 391, 61 Stat. 652, 17 U.S.C. Sections 1(a), 1(b), 3 and 4.

Statement of Facts

The jurisdiction of the District Court was invoked under the Copyright Act (17 U.S.C.) and under 28 U.S.C. Section 1338.

Dashiel Hammett is the author of the copyrighted novel "The Maltese Falcon". This novel was published in book form by Alfred A. Knopf, Inc.[1] in 1930.

A few months later, by a written agreement (R. 37, hereinafter called "Hammett grant") Knopf and Hammett, who between them on that date owned *all* rights in the novel, granted to Warner Bros. Pictures, Inc., exclusive motion picture, dramatic (excepting "spoken stage"), radio and television rights in the novel (R. 38-42). The grant to Warner was under copyright.[2]

The leading character of "The Maltese Falcon" was the fictional detective Sam Spade. Sam Spade was new and original with Hammett, and made his first appearance in the novel (R. 100, 189). Hammett described Sam Spade as the "fictional, literary and dramatic character originated, conceived and created by me [Hammett] known as 'Sam Spade'" (R. 51). In the novel Spade was accompanied by other new and original characters, notably his secretary Effie Perrine and police lieutenant Dundy. These were not stock characters but were well-developed

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[1] Knopf is the holder of record of the copyright and is therefore a nominal party plaintiff and nominal petitioner herein.

[2] (i) Subdivision (f) of Article 2 warrants that the novel is "validly copyrighted * * * and that the Purchaser, under this grant, will have the exclusive right, by reason of the * * * copyrighted nature of said [novel] * * * to the motion picture rights therein, and all rights herein conveyed and granted to Purchaser" (R. 43).

(ii) In Article 7 Knopf and Hammett give Warner *the right to enforce and protect "under any and all copyrights,"* the rights given to Warner in the agreement (R. 46). (emphasis supplied)

(iii) Knopf, as record holder of the copyright, gave Warner for record purposes an "Assignment of Copyright" (R. 447).

and distinctive. In its analysis of the novel, the Court of Appeals said:

> "These characters are skillfully depicted in a running attractive style and distinctly assume individualism as distinguished from mere other persons." (Appendix B, *infra*, p. 29).

There is no issue in the instant case in this respect. These characters, and especially Sam Spade, are important parts of the novel.

Pursuant to the rights granted to it in the Hammett grant, Warner produced three motion pictures. The last of these was released in 1941 under the title "The Maltese Falcon", and was an outstanding success.

After the success of this Warner picture, Hammett granted by mesne assignments to certain of the respondents, including the Columbia Broadcasting System, the "sole and exclusive right to the use in the fields of radio, television, motion pictures and/or any other media of the entertainment industry", the "fictional, literary and dramatic character originated, conceived and created by me [Hammett] known as 'Sam Spade' " (R. 51). Later Hammett orally extended this grant to include the other characters from the novel (Appendix B, *infra*, p. 22).

Pursuant to this grant Columbia Broadcasting System broadcast for a number of years a radio series known as "The Adventures of Sam Spade". This series was broadcast weekly from 1946 to 1950 in some 180 half-hour episodes. A longer episode under the title "The Kandy Tooth" was presented a second time as part of another series called "Suspense" (Finding XXI, R. 108).

Each program was a separate episode in which Sam Spade solved a case. Each program also, with rare exceptions, included Effie Perrine and police lieutenant

Dundy. Occasionally still other characters from "The Maltese Falcon" were used and the novel was referred to by title. The announcer each week referred to Spade as "Dashiell Hammett's famous private detective" (Exs. 4a1-4c15). The Sam Spade of the radio was portrayed with the same characteristics as the Sam Spade of the novel and the same is true of the other characters.

There is no issue of fact in the present case that the characters contained in the novel (i.e., Sam Spade, Effie Perrine, Lieutenant Dundy, and some of the others mentioned by name), were the *identical characters* with the same characteristics as those used in the radio series, and that they were copied from the novel, and the court so found (R. 90).

The respondents, however, claimed that Hammett's prior grant to Warner of the exclusive motion picture, radio and television rights under copyright in the novel did not convey exclusive rights to use the characters. Respondents claimed that the characters appearing in the novel are not included in or protected by the copyright which protects the novel, and therefore Hammett's grant of rights in the novel to Warner under the copyright, did not give Warner exclusive rights in the characters. Consequently, they argued, Hammett was fully within his rights in authorizing the other respondents to use the characters in the radio series, and such use did not constitute infringement of Warner's rights in the copyright. Furthermore, they argued, since Hammett had these rights, the use of these characters in the radio series did not constitute unfair competition.

Warner, joining Knopf as nominal party plaintiff, instituted the instant action against Columbia Broadcasting System and the other respondents, who were an adver-

tising agency, a sponsor, producers and writers. Hammett was later joined as a defendant. The action was for copyright infringement and unfair competition, and an injunction and damages were sought. Warner contended that the use in the radio broadcasts of Sam Spade and the other characters copied from the novel constituted copyright infringement of its rights in the novel and also unfair competition.[3]

The District Court sustained the contentions of the respondents and the Court of Appeals affirmed. The court held that the characters contained in "The Maltese Falcon" were not protected by the copyright which protects the novel, and that the Hammett grant did not give Warner exclusive rights in Sam Spade and the other characters. Consequently, the court held Hammett was within his rights in granting the right to use the characters for broadcasting purposes, and thus the use of the characters was not copyright infringement, nor unfair competition. Judgment was entered dismissing the complaint.

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[3]During the pendency of the instant case in the District Court Hammett sought by Declaratory Judgment in the District Court for the Southern District of New York, a partial determination of the issues involved. His claim was rejected, both in the District Court 84 F. Supp. 28 (1949), and on appeal, 176 F. 2d 145 (CCA 2, 1949), the Second Circuit Court of Appeals stating that it could not decide the controversy in the absence of the other interested parties. In that connection the Second Circuit stated that "the legal questions raised by Hammett's complaint concern the scope of the protection accorded by the copyright assigned to the appellee [Warner]" 176 F. 2d 145, 149.

Hammett counterclaimed in the instant action for a declaratory judgment and was successful in the District Court. The Court of Appeals reversed, dismissing the counterclaim on the ground that it would serve no useful purpose since the judgment to be entered in accordance with its opinion would settle all the issues in the case.

REASONS FOR GRANTING THE WRIT

1. The decision below held that the Copyright Act does not protect characters.

(a) *The court's holding.*

The court lays the groundwork for its decision in the following language (Appendix B, *infra*, p. 21):

> "No question as to the legality of the copyright on The Maltese Falcon or to its continuing effectiveness through all times in suit, or to its complete beneficial ownership by Hammett and Knopf together, is in issue. Therefore, at the effective moment of the grants by Hammett and Knopf to Warner, the latter became possessed of the sole and exclusive right to the writing *which is within the copyright*, less all limiting terms of the grants."[4]

The court then devotes a part of its opinion to a discussion of general principles of contract interpretation. But the court also rests its decision squarely on its interpretation of the Copyright Act that "the writing which is within the copyright" does not include characters.

On this point the court says (Appendix B, *infra*, pp. 25, 26):

> "It will now be profitable to consider whether it was ever intended by the copyright statute that characters with their names should be under its protection. * * *
>
> "It is our conception of the area covered by the copyright statute that when a study of the two writings is made and it is plain from the study that one of them is not in fact the creation of the putative author, but instead has been copied in substantial part exactly or in transparent re-phrasing to produce essentially the story of the other writing, it infringes."

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[4] All emphasis herein is supplied.

> "It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright. * * *"
>
> "We conclude that even if the Owners assigned their complete rights in the copyright to The Falcon, such assignment did not prevent the author from using the characters used therein, in other stories. The characters were vehicles for the story told, and the vehicles did not go with the sale of the story."

(b) *The court's error in interpreting the Copyright Act gave rise to its erroneous interpretation of the Hammett grant.*

Inherent in the court's interpretation of the Hammett grant was its mistaken conception of the Copyright Act. The court found the language of the Hammett grant to be ambiguous because rights in the characters were not specifically conveyed. Because of this "ambiguity" it admitted parol evidence as to the intention of the parties and engaged in an elaborate discussion of rules of contract interpretation.

But the Hammett grant is a clear grant to Warner of exclusive motion picture, radio, and television rights under copyright in "The Maltese Falcon," and the character Sam Spade is an important part of that work. Plot is not mentioned in the Hammett grant but no one would contend that such an essential part of the work is not covered by the grant. There was no more necessity for mentioning characters in the grant than there was for mentioning plot. If original and distinctive characters in a copyrighted novel are protected by the copyright as petitioner contends, there is no ambiguity in the Ham-

mett grant, and no basis for admitting parol evidence as to intention.[5]

2. The effect of the court's decision.

The most obvious effect of the court's decision is that the Copyright Act would not prevent the piracy of distinct and original characters in a copyrighted work. Any one could publish a detective story copying Sam Spade and the other characters from The Maltese Falcon but using them in different situations (capers), and Hammett and Knopf could not invoke the remedies of the Copyright Act to stop the publication.

The court ignores this disastrous result. But even if this result with respect to the Copyright Act is accepted, there remains the further difficulty,—If the characters in a published copyrighted novel are not protected by the copyright, are they protected in any other way? The Court of Appeals merely said that "even if the Owners assigned their complete rights in the copyright to The Falcon, such assignment did not prevent the author from using the characters used therein, in other stories" (Appendix B, *infra*, p. 26).

The District Court was bolder and stated that the characters in the published copyrighted novel are protected by common law (R. 86). We shall discuss the effect of the decision, first on the assumption that such charac-

[5]The Court of Appeals, as did the District Court, relied on a custom said to exist in the publishing field that an author who sold the exclusive right to publish his work in book form retained the right to re-use the characters portrayed therein. But there was no evidence that any such custom exists in the motion picture, radio or television fields. The book publisher obtains merely the right to print and vend the novel in the form in which it is written whereas the motion picture, radio and television industries, as well as the legitimate theatre, add to, subtract from and adapt the novel and, in short, use it as raw material for their own creative productions. Putnam, *Authors and Publishers* (New York 1897); *Dam* v. *Kirke La Shelle Co.*, 175 Fed. 902 (CCA 2, 1910). Obviously a custom applicable to one field would not apply to the other.

ters are protected at common law and then on the assumption that they are not.

If the characters of a published copyrighted novel are protected by common law, then Sam Spade belongs to Hammett and his heirs and assigns forever, and never falls into the public domain. If Sam Spade never goes into the public domain, then Tom Sawyer, Mr. Pickwick, D'Artagnan, Jean Valjean and other classical characters too numerous to mention, belong in perpetuity to the heirs or assigns of their respective creators.

But the law is clear that the characters of a published novel are not protected by common law. When a work of fiction is published, all of it which is not protected by the Copyright Act goes into the public domain. *Wheaton* v. *Peters*, 8 Pet. 591 (U. S., 1834); *Holmes* v. *Hurst*, 174 U. S. 82 (1899); *Bobbs-Merrill* v. *Straus*, 210 U. S. 339 (1908).

In *Kurlan* v. *C.B.S.*, 40 Cal. 2d 799, 256 P. 2d 962 (1953), the court stated that after publication the "My Sister Eileen" characters are not protected by the common law.

Consequently, when "The Maltese Falcon" was published in 1930, under the court's decision that the characters are not protected by copyright, Hammett would have lost all rights in Sam Spade. Such a result would cut the heart out of the copyright statute. There would be no other remedy to the author because it is settled law that if a work is not protected by copyright its appropriation does not constitute unfair competition. *Atlas* v. *Street & Smith* ("Nick Carter"), 204 Fed. 398 (CCA 8, 1913), cert. den. 231 U. S. 755 (1913); *National Comics* v. *Fawcett* ("Superman"), 191 F.2d 594 (CCA 2, 1951); *Archie*

Comics v. *American News Co.* ("Archie"), 125 N. Y. S. 2d 919 (1953), affirmed 129 N. Y. S. 2d 915 (1954).

3. The holding of the Ninth Circuit conflicts with holdings of the Second Circuit.

In *Nichols* v. *Universal*, 45 F.2d 119 (CCA 2, 1930), the Second Circuit held that where the characters are "stock figures", like "the low comedy Jew and Irishman" in the stage play "Abie's Irish Rose", they are not protected by the copyright of the play. But in his opinion in that case, Chief Judge Learned Hand clearly indicated that if the characters were original and well-developed they would be protected by copyright, using as examples, Sir Toby Belch and Malvolio from *Twelfth Night*.

The problem was squarely presented to the Second Circuit in *Detective Comics* v. *Bruns*, 111 F.2d 432 (CCA 2, 1940). There the court held that the comic strip character "Superman" was protected by copyright. The court applied the principles underlying the *Nichols* case, drawing no distinction between comic strip and literary characters in determining whether they are sufficiently original and distinct to be protected. In sustaining a decree enjoining infringement, C.J. Augustus Hand said, at 433:

> "Defendants attempt to avoid the copyright by the old argument that various attributes of 'Superman' find prototypes or analogues among the heroes of literature and mythology. But if the author of 'Superman' has portrayed a comic Hercules, yet if his production involves more than the presentation of a general type he may copyright it and say of it: 'A poor thing but mine own'. * * * So far as the pictorial representations and verbal descriptions of 'Superman' are not a mere delineation of a benevolent Hercules, but embody an arrangement of incidents and literary expressions original with the

author, they are proper subjects of copyright and susceptible of infringement because of the monopoly afforded by the act."

A like holding was made by the same court in *King Features Syndicate* v. *Fleischer,* 299 Fed. 533 (CCA 2, 1924), which held that the manufacture and sale of a toy comic racehorse called "Sparkplug" infringed the copyright of a book of cartoons containing pictorial illustrations of the horse. To the same effect, as to "Betty Boop", is *Fleischer* v. *Freundlich,* 73 F.2d 276 (CCA 2, 1934), cert. den. 294 U. S. 717 (1935), and, as to "Mutt and Jeff", is *Hill* v. *Whalen & Martell,* 220 Fed. 359 (S.D.N.Y., 1914).

The record in the instant case makes it clear that Sam Spade, Effie Perrine and Lieutenant Dundy are not "stock" or "general type" figures but are original, well-developed and distinctive. Without doubt the Second Circuit would hold that those characters are protected by the copyright of the novel "The Maltese Falcon."

4. The holdings of the Second Circuit are correct and the Ninth Circuit is in error.

Analysis of the Copyright Act[6] supports the Second

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[6] The first copyright statutes gave the author but one right, namely that after he wrote his work and published it, he retained the exclusive right to publish it as it was written and published. He could not prevent any other use of the work, such as dramatizing, using individual scenes, translating, abridging, etc. But by successive steps, the author was given the following exclusive rights in his published work of fiction:

First: To *perform* his work if it was a dramatic work (Act of 1856, c. 169, 11 Stat. 138).

Second: To *use individual scenes* from his work apart from the whole. *Daly* v. *Palmer,* Fed. Cas. No. 3552 (C.C., S.D.N.Y., 1868).

Third: To *make dramatizations* (Act of 1870, c. 230, 16 Stat. 212).

Fourth: To *make translations* (Act of 1870, c. 230, 16 Stat. 212).

Fifth: To *make abridgements or digests* (Act of 1909, c. 320, 35 Stat. 1075—see *Amdur on Copyright,* pp. 762 and 764).

Circuit's position that the original and distinctive characters of a copyrighted work of fiction are protected by the copyright.

(a) Section 1(a) grants to the author or proprietor of a work the exclusive right to "copy" it. That Section has been held to prohibit the unauthorized copying of any substantial portion of a work, such as copying a scene in *Daly* v. *Palmer*, Fed. Cas. No. 3552 (C.C., S.D.N.Y., 1868), or the dramatic sequence or plot in *Sheldon* v. *M-G-M*, 81 F.2d 49 (CCA 2, 1936).

(b) Section 1(b) gives the author or proprietor of a work the exclusive right to make "other versions". The use of characters in new situations has been held to be the making of "other versions". *National Comics* v. *Fawcett*, 191 F.2d 594 (CCA 2, 1951).

(c) Section 1(b) also gives the author or proprietor of a work the exclusive right to "dramatize". The use of characters in new dramatic situations has been held to

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Sixth: To *use the plot and dramatic sequence* in other works. *Dam* v. *Kirke La Shelle Co.*, 175 Fed. 902 (CCA 2, 1910); *Sheldon* v. *M-G-M*, 81 F. 2d 49 (CCA 2, 1936).

Seventh: To *use original and distinctive characters* from the work in other works. *Nichols* v. *Universal*, 45 F. 2d 119 (CCA 2, 1930); *Detective Comics* v. *Bruns*, 111 F. 2d 432 (CCA 2, 1940).

This development has culminated, as shown in Seventh above, in affording to the author the protection of the copyright statute in the exclusive use of the original and distinctive characters which he creates, a right which the instant case would take away from him.

The court below based its decision in part on the failure of the Copyright Act to mention "characters" as being specifically protected, but from the very beginning the Copyright Acts have been drawn with language protecting the work against *uses*, and have not specified the *parts* of the work which are protected. Under the court's reasoning, since there is no mention in the Acts of plot, dialogue, incidents or scenes, these parts of the work would not be protected.

invade the rights of the proprietor of dramatic rights. *Hill* v. *Whalen & Martell,* 220 Fed. 359 (S.D.N.Y., 1914).

(d) Section 3 expressly protects component parts of a work. Characters have been held to be "component parts" within the meaning of the statute. *King Features* v. *Fleischer,* 299 Fed. 533 (CCA 2, 1924).

In sum, original and distinctive characters of a copyrighted work of fiction are protected by the Copyright Act.

5. Unfair competition.

If the Second Circuit is correct in holding that original and distinctive characters are protected by the Copyright Act, then Warner acquired exclusive rights to use Sam Spade for motion pictures, radio and television, and the Ninth Circuit was in error in holding that the radio broadcasts, "Adventures of Sam Spade", did not unfairly compete with Warner's rights. *Patten* v. *Superior Talking Pictures,* 8 Fed. Supp. 196 (S.D.N.Y., 1934).

Further, since the Hammett grant gave Warner exclusive motion picture, radio and television rights in the novel, Warner is entitled to prevent any competing use of those rights authorized by Hammett. *Manners* v. *Morosco,* 252 U. S. 317 (1920).

CONCLUSION

The issue in this case involves an important question of copyright law. The decision of the court below is the only reported case holding that original and distinctive characters in a published copyrighted work are not protected by the copyright. This holding conflicts with the holdings of the Second Circuit. The question is one which has not been, but which should be settled by this Court.

For the foregoing reasons this petition for writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX A

Statutes Involved

17 U.S.C. Sections 1(a), 1(b), 3 and 4 as amended

§ 1. Exclusive rights as to copyrighted works

Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:

(a) To print, reprint, publish, copy, and vend the copyrighted work;

(b) To translate the copyrighted work into other languages or dialects, or make any other version thereof, if it be a literary work; to dramatize it if it be a nondramatic work; to convert it into a novel or other nondramatic work if it be a drama; to arrange or adapt it if it be a musical work; to complete, execute, and finish it if it be a model or design for a work of art; * * *

* * * * *

§ 3. Protection of component parts of work copyrighted; composite works or periodicals

The copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted, and all matter therein in which copyright is already subsisting, but without extending the duration or scope of such copyright. The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted under this title.

* * * * *

§ 4. All writings of author included

The works for which copyright may be secured under this title shall include all the writings of an author.

APPENDIX B

Opinion of the United States Court of Appeals, For the Ninth Circuit

CAPTION

No. 13,457.
Nov. 9, 1954.

APPEAL FROM THE UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA
CENTRAL DIVISION

Before: STEPHENS and FEE, Circuit Judges, and CLARK, District Judge

STEPHENS, Circuit Judge

Dashiell Hammett composed a mystery-detective story entitled *"The Maltese Falcon"* which was published serially, and each installment was copyrighted by the publisher. Subsequently, Alfred A. Knopf, Inc., entered into a contract with the author to publish the work in book form. Knopf published the book and, in accord with the terms of the contract, copyrighted it.

In 1930, after publication in book form and after publication of all installments of the first serial thereof, Knopf and Hammett, designated as "Owners", for a consideration of $8,500.00, granted certain defined rights in and to The Maltese Falcon (called "writings" in the agreement) to Warner Bros., as "Purchaser".[1] Coin-

[1] The Hammett-Knopf-Warner contract, with certain formalities deleted as in the district court's memorandum decision of December 28, 1951, 102 F. Supp. 141, 143, is as follows:

"* * * Warner as 'Purchaser' was granted the following rights inter alia 'in and to that certain story, hereinafter called "writings",

cidentally, Knopf executed an instrument to Warner called "Assignment of Copyright" [2] for a nominal consideration.

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entitled "Maltese Falcon" * * *: 1. (a) the exclusive * * * motion picture rights including, common law and statutory copyright in the same * * * together with all benefits of the copyrights in such writings, the title and the theme thereof, and of all remedies held thereunder, with respect to such motion picture rights; (b) the exclusive right to make motion picture versions thereof * * * including the exclusive right to show * * * photographs in motion, representing scenes or action taken from or based upon said writings, or any adaptation thereof; (c) the exclusive right to record and reproduce language, speech, songs, music, dancing, choreography and other sounds in connection with * * * the production and exhibition of photoplays based upon such writings * * *; (d) the exclusive right for the purpose of such sound records and photoplays, to adapt, use, dramatize, arrange, change, transpose, make musical versions of, add to, interpolate in and subtract from said writings, the language, title and dialogue thereof * * *; (e) the exclusive right to record such writings, language and dialogue and such adaptations, dramatizations, arrangements, change * * * and interpolations on sound records and to reproduce the same from such sound records in synchromism with and/or separately from such photoplays * * *; (f) the right in the writings for production and use upon the spoken stage * * * is reserved to the Owners, but all other now or hereafter existing dramatic, exhibition or other presentation rights in the writings, and without limiting the generality of the foregoing, including talking motion picture rights * * * as well as the right to transmit and exploit scenes and pictures taken or adapted from or based upon said writings, the language, title and dialogue thereof, by radio, television or otherwise, together with the right to transmit and reproduce by radio, television or otherwise, the writings, the language, title and dialogue thereof and the sound records herein referred to in connection with the broadcastings of said motion picture versions * * * are granted exclusively to the Purchaser * * * [and] 12. The Owners warrant and agree that they will not cause or allow or sanction any publication or dramatization of said writings or any arrangement, or version or reissue thereof in any form in any parts of the world, without first granting to the Purchaser, without further consideration, the silent and talking motion picture rights and the mechanical and recording and reproducing rights (and all the rights set forth in paragraph (1) hereof) and in and to any such arrangement, revision or reissue above named.' "

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[2] "ASSIGNMENT OF COPYRIGHT. Whereas, Dashiell Hammett is the author of a certain literary composition entitled "Maltese Falcon", five

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The text of the "assignment" shows on its face that it is not an assignment of the copyright but that it is a grant to Warner of specified rights to the use of the writings in The Maltese Falcon. Both the contract between Hammett-Knopf and Warner, and the "assignment" from Knopf, purport to grant to Warner certain defined and

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installments of which have been published * * * and have been copyrighted by Pro-Distributors Corporation; and

"Whereas, the Pro-Distributors Corporation has heretofore assigned to the Undersigned, Alfred A. Knopf, Inc., the foregoing copyrights, and

"Whereas, the Undersigned published a novel, "Maltese Falcon" in book form, and registered the novel in United States Copyright Office * * *,

"Now, Therefore, in consideration of the sum of One Dollar in hand paid and for other valuable considerations now received, the Undersigned sells and assigns unto Warner Bros. Pictures, Inc., its successors and assigns forever, the motion picture and talking motion picture rights * * * in and to the said literary composition (hereinafter called 'writings') and all motion picture rights in all copyrights thereof, as well as radio broadcasting and television rights, * * * together with the sole and exclusive right to use, interpolate songs, music, sounds, words and dialogue in, translate, adapt and change said writings and the title in the making of or in conjunction with or separately and apart from motion picture photoplays, and to lease, vend and exhibit the same throughout the world, and to copyright the same in its own name or otherwise, including the right to record and reproduce sounds, language, dialogue and speech taken, adapted and translated from the writings, in connection with and/or in synchronism with and/or separately from the production and exhibition of photoplays based upon such writings, whether such records be on the film itself or on separate discs, or any other material or medium, by means of mechanical, electrical, photographic or other devices and improvements thereupon which are now or hereafter may be used in connection with the production and exhibition of motion pictures (hereinafter referred to as 'sound records') and to copyright in its own name or otherwise said sound records.

"The Undersigned agrees to obtain or cause to be obtained a renewal of such copyrights according to law in order to secure said rights in Warner Bros. Pictures, Inc., during any and all renewal terms, and the Undersigned hereby appoints Warner Bros. Pictures, Inc., its attorney-in-fact with an irrevocable power to do all acts and things for and in the name of the Undersigned to obtain such renewals.

"Dated: June 23, 1930."

detailed exclusive rights to the use of The Maltese Falcon "writings" in moving pictures, radio, and television.

By the common law, the author of a writing possesses the sole and exclusive right to publish it, but upon and after the first publication the writing may be published by anyone including the author, since the writing has gone into the public domain. *Bobbs Merrill Co. v. Straus,* 1908, 210 U.S. 339; *Bobbs Merrill Co. v. Straus,* 1908, 147 F. 491; *Harper Bros. v. M. A. Donohue & Co.,* 1905, 144 F. 491. The copyright statute extends the author's sole and exclusive right in accordance with its terms and provisions. *Constitution of the United States,* Art. I, Sec. 8, Clause 8; Title 17 U.S.C.A.; *Bobbs Merrill Co. v. Straus,* 1908, 210 U.S. 339; *Bobbs Merrill Co. v. Straus,* 1908, 147 F. 15. In other words, it reserves the writing from the public domain for the effective period of the copyright. What we have just said is what is meant by courts when they say: "When the copyright comes in, the common law right goes out."

No question as to the legality of the copyright on The Maltese Falcon or to its continuing effectiveness through all times in suit, or to its complete beneficial ownership by Hammett and Knopf together, is in issue. Therefore, at the effective moment of the grants by Hammett and Knopf to Warner, the latter became possessed of the sole and exclusive right to the writing which is within the copyright, less all limiting terms of the grants. The grants are limited to defined uses in motion picture, talking pictures, radio, and television.

It is claimed by Warner that it acquired the exclusive right to the use of the writing The Maltese Falcon, including the individual characters and their names, together with the title, "The Maltese Falcon", in motion

pictures, radio, and television. The use of the title is not in issue, since the grant to Warner specifically includes it.

It is the position of Hammett and the other defendants, all of whom claim some interest under him, that the rights acquired by Warner are those specifically mentioned in the conveying or granting instruments, and that the exclusive right to the use of the characters and/or their names were not mentioned as being granted; that the instruments, properly construed, do not convey any exclusive right to the use of characters with or without names, hence Hammett could use them in other stories. However, if, by reason of the silence in the instruments as to such claimed rights, the instruments should be held to be ambiguous on this point, the custom and practice demonstrate that such rights are not customarily parted with by authors, but that characters which are depicted in one detective story together with their names are customarily retained and used in the intricacies of subsequent but different tales.

Hammett did so use the characters with their names and did contract with others for such use. In 1946 he used The Maltese Falcon characters including Sam Spade, the detective and the leading character in the Falcon, by name, and granted to third parties the sole and exclusive right, except their use in the Falcon, to use that character by name (later orally enlarged to include other characters of the Falcon) in radio, television, and motion pictures. Under such claimed rights, radio broadcasts of "Adventures of Sam Spade", including "The Kandy Tooth" were broadcast in weekly half-hour episodes from 1946 to 1950.

Warner claims infringement of copyright and "unfair use and "competition" by such re-use and, as well, for

infringement of parts of the story and the whole of the writing inclusive of characters and their names. Hammett and the other defendants deny infringement or unfair use and competition on any count, and Hammett requests the court to declare his rights in the premises. Knopf is a nominal party asking and claiming nothing, and is made a plaintiff under the right granted Warner in the Hammett-Knopf-Warner contract.

The trial court denied relief to Warner, declared Hammett's rights, and assessed costs against Warner, who appeals.

The instruments under which Warner claims were prepared by Warner Bros. Corporation which is a large, experienced moving picture producer. It would seem proper, therefore, to construe the instruments under the assumption that the claimant knew what it wanted and that in defining the items in the instruments which it desired and intended to take, it included all of the items it was contracting to take.[3] We are of the opinion that since the use of characters and character names are nowhere specifically mentioned in the agreements, but that other items, including the title, "The Maltese Falcon", and their use are specifically mentioned as being granted, that the character rights with the names cannot be held to be within the grants, and that under the doctrine of *ejusdem generis,* general language cannot be held to include them.[4] As was said in *Phillip v. Jerome H.*

[3] Taylor v. U. S. Casualty Co., 269 N.Y. 360, 199 N.E. 620; Evelyn Building Corp. v. City of New York, 257 N.Y. 501, 178 N.E. 771; Tobani v. Carl Fischer Inc., 1942, 33 NYS.2d 294, 299; Hunt v. United Bank & Trust, 1930, 210 Cal. 108, 116, 281 P. 184.

[4] Bouvier's Law Dictionary, Baldwins Students Ed., 1934, p. 336; 3 Williston on Contracts, Rev.ed., 1784. See, also, Smith v. McCullough, 1881, 104 U.S. 25, 28; Swift & Co. v. Columbia Ry. Gas & Electric Co., 1927, 17 F.2d 46, 48; Cleveland Trust Co. v. Consolidated Gas etc. Co., 1932, 55 F.2d 211, 215.

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Remick & Co., S.D., N.Y., Op. No. 9,999, 1936, "Such doubt as there is should be resolved in favor of the composer. The clearest language is necessary to divest the author of the fruits of his labor. Such language is lacking here." See, also, *Tobani v. Carl-Fischer, Inc.*, 1942, 263 App. Div. 503, 507, 33 NYS2d 294, 299, affirmed 1942, 289 N.Y. 727.

The conclusion that these rights are not within the granting instruments is strongly buttressed by the fact that historically and presently detective fiction writers have and do carry the leading characters with their names and individualisms from one story into succeeding stories. This was the practice of Edgar Allen Poe, Sir Arthur Conan Doyle, and others; and in the last two decades of S. S. Van Dine, Earle Stanley Gardner, and others. The reader's interest thereby snowballs as new "capers" of the familiar characters are related in succeeding tales. If the intention of the contracting parties had been to avoid this practice which was a very valuable one to the author, it is hardly reasonable that it would be left to a general clause following the specific grants. Another buttressing fact is that Hammett wrote and caused to be published in 1932, long after the Falcon agreements, three stories in which some of the leading characters of the Falcon were featured, and no objection was voiced by Warner. It is also of some note that the evidence shows that Columbia, long subsequent to the conveying instruments, dickered with Warner for the use of the Falcon on its "Suspense" radio program and, failing in its efforts, substituted "The Kandy Tooth" which uses the Falcon characters under license of Hammett. Warner made no claim against Columbia at or reasonably soon afterward. The conclusion we have come to, as to the intention of the parties, would

seem to be in harmony with the fact that the purchase price paid by Warner was $8,500.00, which would seem inadequate compensation for the complete surrender of the characters made famous by the popular reception of the book, The Maltese Falcon; and that the intention of the parties, inclusive of the "Assignment", was not that Hammett should be deprived of using the Falcon characters in subsequently written stories, and that the contract, properly construed, does not deprive Hammett of their use.

Up to this point we have discussed the points at issue by construing the contract and by seeking the intention of the parties to it, and we have concluded that the parties never intended by their contract to buy and sell the future use of the personalities in the writing.

It will now be profitable to consider whether it was ever intended by the copyright statute that characters with their names should be under its protection.

The practice of writers to compose sequels to stories is old, and the copyright statute, though amended several times, has never specifically mentioned the point. It does not appear that it has ever been adjudicated, although it is mentioned in *Nichols v. Universal Pictures Corp.*, 1930, 45 F.2d 119. If Congress had intended that the sale of the right to publish a copyrighted story would foreclose the author's use of its characters in subsequent works for the life of the copyright, it would seem Congress would have made specific provision therefor. Authors work for the love of their art no more than other professional people work in other lines of work for the love of it. There is the financial motive as well. The characters of an author's imagination and the art of his descriptive talent, like a painter's or like a person with his penman-

ship, are always limited and always fall into limited patterns.[5] The restriction argued for is unreasonable, and would effect the very opposite of the statute's purpose which is to encourage the production of the arts.

It is our conception of the area covered by the copyright statute that when a study of the two writings is made and it is plain from the study that one of them is not in fact the creation of the putative author, but instead has been copied in substantial part exactly or in transparent rephrasing to produce essentially the story of the other writing, it infringes.

It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright. The subject is given consideration in the *Nichols* case, supra, at page 121 of the citation. At page 122 of the same case the court remarks that the line between infringement and non-infringement is indefinite and may seem arbitrary when drawn; nevertheless it must be drawn. *Nichols v. Universal Pictures Corp.*, 1930, 45 F.2d 119. See *Warner Bros. Pictures v. Majestic Pictures Corp.*, 70 F.2d 310, 311.

We conclude that even if the Owners assigned their complete rights in the copyright to the Falcon, such as-

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[5] "He must be a poor creature that does not often repeat himself. Imagine the author of the excellent piece of advice, 'Know thyself', never alluding to that sentiment again during the course of a protracted existence! Why, the truths a man carries about with him are his tools; and do you think a carpenter is bound to use the same plane but once to smooth a knotty board with, or to hang up his hammer after it has driven its first nail? I shall never repeat a conversation, but an idea, often. I shall use the same types when I like, but not commonly the same stereotypes. A thought is often original, though you have uttered it a hundred times. It has come to you over a new route, by a new and express train of associations." The Autocrat of the Breakfast Table, by O. W. Holmes, M.D., p. 9, reprint of original edition.

signment did not prevent the author from using the characters used therein, in other stories. The characters were vehicles for the story told, and the vehicles did not go with the sale of the story.

We turn to the consideration of general infringement. It is agreed that a story entitled "The Kandy Tooth" is the closest to The Maltese Falcon, and from a practical standpoint if the Tooth does not infringe the Falcon, there has been no infringement.

We have set out in notes 7 and 8 at the end of this opinion, short summations of the two works. There is a sameness in the tricks of spinning out the yarn so as to sustain the reader's suspense a to hinted mystery, and there is a similarity in the two stories in that there is a long complicated search for a lost article of fabulous value. The searches are filled with complications, fatalities, and moral delinquencies by characters in name, description, and action of some similarities. The script of the Tooth was not composed by Hammett and, except for a few expressions, is not written in the Hammett literary style.

We see no clear error in the trial court's holding that the similarities of the two stories do not go to the degree of constituting practically the same story. There is no textual copying; the mystery of the Tooth and the suspense to the reader would not be dulled through his having read the Falcon. In a phrase, they are different stories though of the same general nature.

Unfair Use and Competition

Warner claims the radio broadcasts, "The Adventures of Sam Spade" and the "Suspense" broadcast of "The Kandy Tooth", and others, wherein the characters of the Falcon were used by name and their peculiarities, con-

stituted unfair use and competition. The trial court found against such contention and we think the conclusion does not constitute clear error.

It is patent that the characters of The Maltese Falcon could not fairly be used in such a manner as to cause the Falcon to be materially lessened in its commercial worth by degrading or cheapening them so that the public would not be interested in their capers.[6] They could not be used in such a manner as to deceive the public or to "palm off" to the public the idea that they were really witnessing The Maltese Falcon when they viewed showings of the other stories.[7] We think there was no reversible error in the court's conclusions on these points.

Although we have thought it necessary to arrive at some conclusions not entirely in accord with those of the district court, or to arrive at like conclusions through somewhat different reasoning, nevertheless we commend a reading of that court's opinion and notation of authorities cited. We are in complete accord with the order of the district court that the plaintiffs-appellants take nothing, and that defendants-appellees recover their costs.

The judgment in accordance with this opinion will settle all of the issues of the case, including all of Hammett's interest in the subject matter under Warner's claims. There is no justiciable controversy between Hammett and Knopf, the nominal plaintiff. It follows that no useful purpose could be served by considering Hammett's prayer for a declaration of his rights and his counterclaim for a declaratory judgment is therefore dismissed and the judg-

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[6] Manners v. Morosco, 1919, 252 U.S. 347; Harper Bros. v. Klaw, 1916, 232 F. 609.

[7] Stork Restaurant v. Sahati, 9 Cir., 166 F.2d 348; Lone Ranger v Cox, 4 Cir., 124 F.2d 650.

ment running to him on it is reversed. Otherwise, the judgment is affirmed.[8] [and] [9]

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[8] THE MALTESE FALCON STORY. The theme of the story of The Maltese Falcon is a complicated search for a fabulously valuable bird figurine called The Maltese Falcon. The action of the story centers in San Francisco from elsewhere, with the leading actors or characters gathering there intent upon the objective. An attractive, alluring woman of uncertain age and reputation, by name Brigid O'Shaughnessy, assuming a false name and great distress, in search of help, called upon private detective Sam Spade, a clever, laconic, rangy-looking man whose morals and practices are none too idyllic, and well if not too favorably known to the police. Brigid qualifies within the requisite of the proverbial monumental liar, but, though Spade is not deceived, she manages to withhold the truth from him. A dunderhead policeman and his partner enter the tangled story. Effie Perine is Spade's secretary, one of those see-all know-all, self effacing paragons of loyal efficiency. A mystical character of a man who apparently is cooperating with Brigid against three others of their search-party gets shot to death and Spade is under suspicion. The leader of the search-party is a fat man named Gutman, of infinite patience and possessed of untold money. He proposes to pay a large sum to Sam who represents that he can deliver the bird. An effeminate lackey of a man by the name of Cairo does Gutman's bidding. A young, boyish gunman is under Gutman's orders. The story runs on at accelerated tempo in mystery until the captain of a ship, just in from the Orient, appears at Spade's apartment with a package in hand and falls dead from the boy's bullets sent into him just before he entered Spade's place. All gather at Sam's for the delivery of the bird, supposed to be in the package, and for payment of the money. Sam gets the award and Gutman gets the bird, which is a worthless counterfeit of the genuine. Gutman maintains his sang-froid. Brigid and Sam have trespassed the conventions. Yet, as somehow it is revealed the lady herself was the author of the first fatality, she is delivered over by the benevolent Sam and is sent on her way to San Quentin prison. These characters are skillfully depicted in a running, attractive style and distinctly assume individualism as distinguished from mere other persons.

Warner claims ownership of all of this including the characterizations with the characters' names, and the story.

[9] THE KANDY TOOTH STORY. The script opens with Sam Spade telephoning from jail to his faithful secretary, Effie Perine, early in the morning. Effie hurries to Sam who dictates his story. Dundy, the police officer, is present. Spade has received a telegram from the fat Caspar Gutman who had been marked "dead" from the end of The Maltese Falcon caper. The telegram is a warning about "an invidious

Appendix B

Reversed and Affirmed in part.

(Endorsed:) Opinion. Filed Nov. 9, 1954.

Paul P. O'Brien, Clerk.

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pair of rogues", a dentist, and a charming woman named Hope Laverne, who have something to do with a "hidden tooth". Spade is bailed out by a mystery man who deposits $20,000.00 with the law. Gutman will shortly arrive in San Francisco. The dentist, so Spade dictated, had been ushered into his office by Effie and entreats him to get someone's "bridge". The dentist leaves. Spade contemplates "Hm-m-m * * * Beware the Hidden Tooth". In comes Hope Laverne, a character along the line of Brigid O'Shaughnessy, and she is, or claims to be, a sister of the dentist. Hope explains the brother's obsession about a dental bridge. She wants to find him. Spade goes to a hotel, gets information from a house detective, and finds the brother, badly beaten; the two walk on the street—the dentist collapses. Spade takes him into a newsreel theater. The show excites him—it's about white elephants and particularly Oriental in character. Spade and the dentist go back to Spade's room. There Laverne recites a story of a tooth having been extracted from the jaw of a sacred body long since the occupant of an Oriental tomb. The tooth was taken by international rogues and installed by the dentist in a bridgework of an innocent refugee. The rogues are now attempting to locate the refugee and regain the priceless tooth.

Hope calls Spade on the telephone for help, and he goes, but is attacked by a boy, brother of the gun-boy in The Maltese Falcon. They scuffle and Spade is felled by a gun butt. He comes to in the presence of the imperturbable Gutman and strange happenings ensue. Spade finally gets the tooth in the ashes of the cremated body of the refugee, Herman Julius. $20,000.00 is paid upon delivery of the package containing the ashes. The tooth, by reason of a religious significance, is worth untold wealth to Gutman if he can produce it. A murder is committed; Hope and Sam had been more than friends. A Russian was mixed up in the plot. When Gutman saw that he had been duped through the delivery to him of the cremation residue, he took it as philosophically as when the bird in The Maltese Falcon turned out to be spurious. It developes that $20,000.00 had been put up for Sam's bail, and Sam puts up the same money as bail for Hope who gets into and out of jail. In some not very clear manner it all ends with no money gained by Spade, but Hope telephones her love after leaving jail, and Effie is not sure that the whole affair will net her a new ribbon for her typewriter.

Appendix B

Judgment of the United States Court of Appeals, For the Ninth Circuit

CAPTION	No. 13,457

JUDGMENT

Appeal from the United States District Court for the Southern District of California, Central Division.

This cause came on to be heard on the Transcript of the Record from the United States District Court for the Southern District of California, Central Division, and was duly submitted.

On consideration whereof, It is now here ordered and adjudged by this Court, that the counterclaim of Dashiell Hammett be, and hereby is dismissed, and the Judgment running to him on it is reversed; otherwise, the Judgment of the said District Court in this cause be, and hereby is affirmed.

(ENDORSED) Judgment
Filed and entered November 9, 1954,
PAUL P. O'BRIEN, Clerk

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STATUTE

31 Corpus Juris Secundum, Sec. 70, p. 651 6

IN THE

Supreme Court of the United States

October Term, 1954
No. 580

WARNER BROS. PICTURES, INC., a corporation, and ALFRED A. KNOPF, INC., a corporation,

Petitioners,

vs.

COLUMBIA BROADCASTING SYSTEM, INC., a corporation; WILLIAM SPIER; THE WILDROOT COMPANY, INC., a corporation; REGIS RADIO CORPORATION, WILLIAM ROBERT TALLMAN, GILES B. DOUD, JOE EISINGER, BATTEN, BARTON, DURSTINE & OSBORN, INC., and DASHIELL HAMMETT,

Respondents.

Answer of Respondents, Columbia Broadcasting System, Inc., a Corporation, William Spier, the Wildroot Company, Inc., a Corporation, Regis Radio Corporation, William Robert Tallman, Giles B. Doud, Joe Eisenger, and Batten, Barton, Durstine & Osborn, Inc., to Petition Warner Bros. Pictures, Inc., and Alfred A. Knopf, Inc., for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

Questions Presented.

1. Does the grant of specified limited rights, not expressly including character or sequel rights, in a copyrighted fictional detective story, prevent the author-grantor and his licensees from thereafter using the same characters in different stories subsequently written, in view of the long-standing and universal custom of detective fiction writers to continue the repeated use of their characters in succeeding stories?

copyrighted product. It is the converse. It is an effort by a grantee of limited rights in the copyrighted work to stop the author and his licensee from using the ungranted portions.

With respect to unfair competition, the title of the radio program was "The Adventures of Sam Spade," which was a part of the title of a book published in 1944, without objection of either Knopf or Warner, of other "Spade" stories written by Hammett after "The Maltese Falcon." Warner never used the name "Sam Spade" as, or as a part of, a title of any motion picture or radio program [R. 453]. Warner at no time made any contention that the broadcasts damaged the characters in any way or were not of fine quality. The Trial Court found, on ample evidence, that there was no palming off by defendants and that there was no public confusion between Warner's motion pictures and defendants' radio programs.

Although it may be quite irrelevant, we feel that the false impression created on page 4 of the Petition, that Columbia Broadcasting System was a proprietor in the radio program, should be corrected. Regis was the owner and producer [R. 454]; Columbia Broadcasting System, together with American Broadcasting Company and National Broadcasting Company [R. 454-455], simply furnished broadcasting facilities under contract, except in the one instance of its broadcast of one of "The Adventures of Sam Spade" scripts, "The Kandy Tooth," on its "Suspense" program.

REASONS FOR DENYING THE WRIT.

I.

The Decision Below Is Right Because Warner Obtained Only Limited Rights, Which Were Not Invaded by Regis' Radio Program.

Respecting the copyright infringement, the decision below is divisible into two parts: first, Warner obtained only limited rights, which were not infringed by defendants; and, second, the copyright alone does not protect character rights.

A. Warner Obtained Only Limited Rights.

Warner's rights arose from the contract of June 23, 1930 [R. 37]. It did not get unlimited rights "in the novel," that is, Hammett's entire creation, but only certain specified rights "in and to that certain story, hereinafter called 'writings,' entitled 'The Maltese Falcon.'" The contract enumerates in minute detail the portions acquired, and the absence of any specification of character or sequel rights is in sharp contrast to the detailed specification of the other rights. As components of the book, the contract expressly refers to the title, the theme, language, dialogue, scenes, and pictures. This is particularly pointed out in the Trial Court's Opinion [R. 79 and 81]. The very content of the contract itself exhibits a most assiduous effort and concern on the part of Warner to procure its rights to the ultimate. It is of utmost significance, therefore, that there is no mention of character or sequel rights.

Under these circumstances, the absence of any mention of character or sequel rights should be sufficient in itself to determine the case in appellees' favor. The most that can be said in aid of Warner's position is that there is an ambiguity, and the presence of this ambiguity invokes two legal propositions: strict construction against Warner, as author of the contract; and recourse to said custom and practice for proper construction.

B. There Is a Well-established Distinction Between Story and Characters in Detective Fiction.

The evidence abundantly shows (and it is so well-known as to be the proper subject for judicial notice [31 C. J. S. 651, Sec. 70]) that, at least from the time of Edgar Allen Poe in 1843, authors of detective fiction have used their same characters in successive and different stories, or "capers," as the word is used in this case. There is an obvious and major distinction between Sir Arthur Conan Doyle's rights in his first *story*, "A Study in Scarlet," which was a final, complete unit in itself, and in his great character, Sherlock Holmes, which he continued to use in so many later stories. The value of the character obviously greatly exceeded the value of any story in which he appeared.

Moreover, "The Maltese Falcon" is primarily a detective story and not a character development [R. 370]. Warner itself recognized this by abandoning entirely the name "Sam Spade" in its second picture based on "The Maltese Falcon," called "Satan Met a Lady," in which the name "Shane" was substituted [R. 274].

The suggested limitation, in the note at the bottom of page 9 of the Petition, of the custom of the continued

use by detective fiction writers of their characters in subsequent stories to the publication field because in its motion picture realm Warner obtained broader rights than the publisher, in that it obtained the story as "raw material" for its own creative purposes, is not well taken, because its use of the material was confined to Hammett's story (*Curwood v. Affiliated Distributors, Inc.*, 283 Fed. 219, 222 (S. D. N. Y., 1922), Knox, D. J.).

Indeed, if Warner's contention be sustained, then, contrary to all custom and usage, Sam Spade and his fellow characters will forever be confined to "The Maltese Falcon," because Warner cannot depart from that story.

Warner was bound by this custom prevailing in the mother field of literature to which it resorted continually for motion picture material, and in which it was a large and important dealer.

Krstovic v. Van Bueren, 235 N. Y. 96, 138 N. E. 749 (1923);

Walls v. Bailey, 49 N. Y. 464, 476 (1872);

Smith v. Clews, 114 N. Y. 190 (1889);

Ermolief v. R. K. O. Radio Pictures, 19 Cal. 2d 543, 552 (1942).

When the ambiguity in the contract of June 23, 1930, is resolved by recourse to said universal custom and practice in detective fiction writing, it is entirely clear that the contract did not convey to Warner character or sequel rights.

II.

The Character Rights Are Not Within the Protection of the Copyright Statute.

The suggestion of disastrous result (to the author, of course) envisioned on page 9 of the Petition, which allegedly would follow if the original characters were excluded from copyright protection, ignores the author's unfair competition remedy, akin to a trademark remedy. There is a distinction between the author's product and the identifying indicia of that product in the public's mind. These indicia, at least in the detective fiction field, are two-fold: title and characters. The consumer asks for an Arthur Conan Doyle detective story either by title of the particular story, if known, or by the name of the detective Holmes. Even the author's name is not a distinguishing feature because Doyle may have written poetry, which is quite outside the customer's desire. A cigarette smoker asks for a Lucky Strike because he desires to smoke a cigarette and he has learned to identify Lucky Strike with the gratification of his desire. He does not ask for an American Tobacco Company product because the producer's name might not be sufficiently definitive; it could include pipe or chewing tobacco, snuff, or even a different kind of cigarette.

Indeed, a tremendous public awareness of Sherlock Holmes and Dr. Watson has developed independently and apart from any one of the A. Conan Doyle stories [R. 336]. It has become a library practice to index detective characters separate from their stories [R. 341]. In 1930,

McGowan was preparing an anthology of great detectives, as distinct from the great detective stories in which they had appeared, during the period antedating the contract of June 23, 1930 [R. 342].

The title of a literary work is not protected by copyright.

Patten v. Superior Talking Pictures, Inc., 8 Fed. Supp. 196;

National Picture Theatres, Inc. v. Foundation Corp., 266 Fed. 208;

Paramore v. Mack Sennett, Inc., 9 F. 2d 66;

Becker v. Loew's, Inc., 133 F. 2d 891;

Detective Comics v. Bruns Publications, 111 F. 2d 432;

Nichols v. Universal Pictures Corp., 45 F. 2d 121.

It is protected, rather by the unfair competition remedy. The author may write successive stories under the same title, even as Warner produced two motion pictures under the same title, "The Maltese Falcon," the right to the use of which was expressly and separately mentioned in the contract.

In like manner, the characters are protectible by the unfair competition remedy.

Fisher v. Star Co., 231 N. Y. 414, 132 N. E. 133;

Johnston v. Twentieth Century-Fox Film Corp., 82 Cal. App. 2d 796;

Jackson v. Universal Pictures Co., 36 Cal. 2d 116.

This is the meaning or clear implication of the statement of the Court of Appeals that "the character is only the chessman in the game of telling the story," and, further, "the characters were the vehicles for the story told, and the vehicles did not go with the sale of the story." Hammett continued the use of Sam Spade in three succeeding stories, significantly without any objection from Knopf, the copyright owner. He could further have continued the use himself in any medium: printing, motion picture, radio, or television, but elected to do so through his licensees, who paid him for it, and whose payments, aggregating about $85,000, at $400 per week, in contrast to the $8,500 paid by Warner under the contract of June 23, 1930, were so much wasted money, if Petitioners' dire lament were well-founded. One would indeed be reckless if he undertook any use of Erle Stanley Gardner's "Perry Mason," without first dealing with Gardner, not because of copyright infringement but because of unfair competition and palming off an imitation on the unsuspecting public. Character rights are analogous to trademark rights, and the author may prevent their use by means of unfair competition remedy in the same manner as the use of titles.

As stated in *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, at 818, 187 P. 2d 474, at 487:

> "We should be realistic. It is common knowledge that since the advent of motion pictures—and particularly since the advent of radio—titles, names, slo-

gans, catch-phrases and the like have become of great value. Agreements for their use in particular fields are common. Large sums are paid for their use in advertising."

An author has such a continuing right in his characters, entirely apart from any copyright rights that he may prevent his own licensee from making any damaging or deteriorating or adulterating use of his characters. This shows a continuing right of the author in his characters separate and apart from any concept of copyright.

Prouty v. National Broadcasting Co., Inc., 26 Fed. Supp. 265.

Publication, instead of setting the characters adrift in the public domain, as argued at page 10 of the Petition, constitutes the factor which establishes their secondary meaning and either identifies them in the public mind with the author or identifies the story containing them as the desired literary product. Thus, publication becomes the *sine qua non* to the vesting in the author of the rights which are protectible by the unfair competition remedy.

The author therefore is not without adequate protection of his characters by means entirely independent of copyright, statutory or common law.

III.

There Is No Conflict Between the Ninth Circuit and the Second Circuit.

Judge Hand's comments in *Nichols v. Universal,* 45 F. 2d 121, were not even dicta; they were speculative reflections. It is submitted that if Judge Hand were confronted with this question, as it is presented by the facts of the case at bar, showing the radical difference between the copyrighted product, the detective story, and its market indicia, the title and characters, he would have been the first to refuse application of his speculation, particularly since the *Nichols* case involved a one-time single use of characters in another type of literary work, in contrast to the custom in the detective fiction field of continued use of the characters in subsequent cases.

The cases of *Detective Comics v. Bruns,* 111 F. 2d 432; *King Features Syndicate v. Fleischer,* 299 Fed. 533; *Fleischer v. Freundlich,* 73 F. 2d 276, and *Hill v. Whalen & Martell,* 220 Fed. 359, referred to under Point 3, beginning at page 11 of the Petition, are not in point because they involve pictures or cartoons which are the direct subjects of copyright protection, as well as textual matter and literary expressions accompanying the pictures and cartoons.

IV.

Warner Is Not Entitled to Any Recovery on the Theory of Unfair Competition.

A. The Essence of Unfair Competition Is Deception of the Public or Palming Off.

Sherwood v. Twentieth Century-Fox Film Corp., 18 N. Y. S. 2d 388, 390;

Atlas Mfg. Co. v. Street & Smith, 204 Fed. 398;

Becker v. Loew's, Inc., 133 F. 2d 891;

Lone Ranger, Inc. v. Cox, 124 F. 2d 650;

Fisher v. Star Co., 231 N. Y. 420.

B. There Is No Direct Evidence or Inference of Any Public Deception or Palming Off.

The evidence is exactly to the contrary. The trial court, construing the evidence, specifically held that there was no deception of the public or palming off [R. 91 and 110].

The important factor is the name, "Sam Spade," and Warner never used that name as a title or as any part of a title of any motion picture or radio or television program.

Warner publicized "The Maltese Falcon" and its star, Humphrey Bogart [R. 291]. In its second picture, "Satan Met a Lady," Warner even substituted a different name, Shane, for Spade. The testimony of Warner's witness, Irwin F. Dolid, showing extensive advertising of "The Maltese Falcon," does not include one word about advertising Sam Spade [R. 468-473].

This program became one of the top mystery programs on the air [R. 514]. It was defendants, not Warner, who

developed a public demand for a product under the name "Sam Spade" [R. 291]. Their billing of Spade is in marked contrast to Spade's anonymity in the motion pictures. Warner developed no secondary meaning in Sam Spade. Instead of the defendants' being guilty of unfair competition, it is Warner who, by this suit, is trying to reap where it has not sown by sitting quietly by for a year and a half while defendants built the name "Sam Spade" into a very valuable property, and then by coming into Court for the purpose of forcing the handing over of this asset.

Conclusion.

The basic and controlling proposition here is that, in detective fiction, the characters universally stand out and exist apart from any particular story and continue to appear in many stories and Warner's contract which conveyed to it only story rights, did not include the separate character rights. Hammett retained his character rights and validly conveyed them to Regis. The broadcasting therefore was legal and there is no basis for Petitioners' action.

Respectfully submitted,

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IN THE

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vs.

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Respondents.

BRIEF OF RESPONDENT DASHIELL HAMMETT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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I. The Question Presented

Did the fictional mystery writer who granted the rights in various fields as to one story, in an agreement silent as to character or sequel rights, thereby debar himself under the circumstances of this case from the use made in later stories in the same fields of named characters originating in such story?

This is the sole decisive question in the case. Its determination in the negative below should not be reviewed by this Court.

II. Statement of the Case

The respondent Dashiell Hammett, is an author of detective and mystery stories who wrote the detective story involved herein, "The Maltese Falcon," some time in 1929. Later in the same year he had this story published serially in separate monthly magazine installments, each separately copyrighted by the magazine publisher. Prior to the writing of that story or on March 29, 1928, he had entered into a contract with the book publisher Knopf relating to another detective work of his, entitled "Red Harvest," pursuant to which Knopf would and did acquire the same rights in the later work "The Maltese Falcon," as it had acquired for "Red Harvest," those rights being expressly limited to those "rights comprised in the copyright to the said work" which were therein "specifically granted" to Knopf (Ex. 33, Third (C); R. 124, 491).

Following this first serial publication and prior to the Warner agreement of June 23, 1930 (Ex. 3; R. 37, 452), Knopf received from the magazine publisher an assignment of the magazine copyrights on "The Maltese Falcon" and published and copyrighted the work in book form. The work was a success (R. 184-186, 474-481). It was the first of the author's four published stories in which his fictional detective character, Sam Spade, appeared. None of the three later stories published after this Warner agreement were ever sold to or used by Warner. His later three Sam Spade stories, one containing "Spade" in its title, first appeared in magazines commencing in 1932. Besides the leading detective character named Sam Spade, there also appeared by name in these stories some of the other characters found in "The Maltese Falcon." Commencing in 1944 these three stories were published in

a collection entitled "The Adventures of Sam Spade and Other Stories by Dashiell Hammett" which was published in several editions, with numerous reprintings (Ex. D; R. 453, 524, 107, 208-212, 458, 520).

In utilizing his characters, particularly Sam Spade as the central detective figure in successive different detective stories the author was following a well-known custom of long standing in the detective story writing field. Long prior to the advent of motion pictures and for well onto a century numerous leading detective story writers followed that practice as did Sir Arthur Conan Doyle in relation to his fictitious detective "Sherlock Holmes" (R. 216, 219, 222-225).

The pivotal contract in this case, the 1930 agreement between Warner the motion picture company as "Purchaser" on the one hand and Knopf the book publisher and Hammett the author on the other as "Owners" (R. 37) was drawn by Warner, a wide and experienced user and dealer in literary properties and provided for its interpretation according to "Federal" and New York law (R. 49). That agreement is conspicuously silent about and shows no sale, grant or disposal concerning name, sequel, character or continuation rights in relation to Sam Spade or other characters. In fact, that name is nowhere mentioned in the agreement; nor is there any covenant or restriction relating to the author's writing of any other stories using any of the characters in "The Maltese Falcon." On its face, that agreement at most purports to transfer for a consideration of $8,500.00 motion picture, radio and television rights in "The Maltese Falcon."

After the execution of this 1930 agreement Warner produced and distributed three motion pictures based upon "The Maltese Falcon", none of them bearing a title containing the name "Sam Spade." The first and third of these, produced in 1931 and 1941 respectively, were entitled "The Maltese Falcon", but the second, produced

in 1936, bore the title of "Satan Met A Lady", and contained no character named Sam Spade therein (R. 107).

On May 15, 1946, the author granted an authorization to certain of the respondents herein for the use in radio and other media of the character Sam Spade and the title "The Adventures of Sam Spade" (Ex. 7, R. 51, 453). Thereafter, commencing in July, 1946, and almost continually to 1950, weekly transcontinental broadcasts entitled "The Adventures of Sam Spade" ensued. These radio programs were written, produced, broadcast and sponsored by the other respondents (R. 103, 109, 454-456). This grant was later orally enlarged to include other characters in "The Maltese Falcon" (R. 109). The radio series reached vast, nation-wide radio audiences, was extensively and regularly advertised and promoted, was highly popular and received a number of radio mystery program awards (Ex. SS; R. 512-515). This series merely used the characters by name. There was no "textual copying" of "The Maltese Falcon" (Petition, Appendix B, p. 27).

Notice of claim by Warner was not given herein until early in 1948 and this suit was not brought until May 28, 1948, or until almost two years after the commencement of these transcontinental broadcasts (R. 457).

Although Knopf was aware of the later Sam Spade stories it has never protested concerning them (R. 501); nor has Warner (R. 103). Nor has Knopf ever protested concerning the radio series. Knopf is a formal party only in this action, makes no claim and has no beneficial interest in Warner's claim (R. 7).

The decision of the District Court dismissing the complaint was unanimously affirmed by the Court of Appeals.

III. Reasons for Denying the Writ

1. The narrow, private and particular contract controversy here presented has been resolved below with unanimous affirmance on grounds just and reasonable.

The rights claimed here by the petitioner Warner derive only from its 1930 agreement, the ultimate source of any such grant. This poses a question of contract construction to ascertain the intent of the parties as to the scope of the transfer. The determination of such a contractual question between private parties on special facts as to rights acquired under a particular contract, presents no issue of public interest or importance for the purpose of review by this Court. This is especially so when the District Court decision dismissing the complaint has received, following a well reasoned opinion, the unanimous affirmance of the Court of Appeals. *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275 (1949).

Moreover, a consideration of the facts and a reading of both opinions below demonstrate that the decision is not only reasonable, but undoubtedly just and correct in resolving the contractual question which is decisive in this case. In arriving at the conclusion that Warner did not acquire the rights claimed, the Court of Appeals pointed to the omission of such language in the contract as would be necessary to sustain Warner's contention; the fact that the contract was prepared by Warner, a large and experienced user and dealer in literary property; the existence of a custom or practice of long duration for detective fiction writers to carry their central or important characters from one story into succeeding stories; the apparent inadequacy of the purchase price if the claimed rights had been included; the conduct of the parties subsequent to the agreement, including the failure of the petitioners to offer any objection to the use by the author of his characaters

in stories later published and to assert the claims herein reasonably soon after the commencement of respondents' broadcasts.

Indeed, the Court of Appeals concluded that the sharply contrasting omission in the Warner prepared instrument of any language with respect to the rights claimed as against the itemization of the rights which were expressly granted, sufficed to show that the rights claimed were not acquired. According to the Court's opinion there was evidently no ambiguity to be resolved. The other facts merely "buttressed" that Court's conclusion. The District Court similarly stressed most of these facts but for the purpose of resolving what it regarded as an omission or ambiguity arising from the contractual silence on the rights in issue.

2. The holding below does not result in any conflict of decisions.

As is self-evident in the opinion below, the holding of the Court of Appeals is solely on the facts of contractual intention.

> "Up to this point we have discussed the points at issue by construing the contract and by seeking the intention of the parties to it, and we have concluded that the parties never intended by their contract to buy and sell the future use of the personalities in the writing." (Petition, Appendix B, p. 25)

The Court then went on to say by way of *obiter dictum* that even if the instant case had involved only an assignment of "complete rights in the copyright" (and without the other facts and the limiting language of the contract in this case) such complete copyright assignment would not prevent the author from using the characters of "The Maltese Falcon" in other stories because these "characters with their names" are not protected by copyright *per se*. (Petition, Appendix B, pp. 26-27). Obviously, the Court's

holding rests on a contractual ground, because the decision would necessarily be the same as a matter of contractual intent under the circumstances of this case even if the court's dictum had been contrariwise.

Not only is the contractual decision itself not at variance with any other decisions, but the dictum itself is consistent with theory expressed and applied in the cases which petitioners cite as the conflicting decisions in the Second Circuit (Petition, point 3, pp. 11, 12).

Under those cases the courts in dealing with the ordinary copyright plagiarism problem—not our situation here—of whether a defendant has appropriated actually or colorably a substantial portion of the plaintiff's literary or cartoon text, conceive the copyright question as one limited to textual appropriation, *i.e.*, whether the expression of pictorial or literary details, including specific incidents or exploits, has been copied. This doctrine is enunciated in the two principal "conflict" cases cited by petitioners. *Nichols* v. *Universal Pictures Corp.*, 45 F. 2d 119, 121 (CCA 2, 1930); *Detective Comics, Inc.* v. *Bruns Publications, Inc.*, 111 F. 2d 432, 433 (CCA 2, 1940). The Second Circuit has recently confirmed this concept, citing these cases. *National Comics Publications, Inc.* v. *Fawcett Publications, Inc.*, 191 F. 2d 594, 600, 603 (1951); *opinion clarified*, 198 F. 2d 927 (1952).

This view has recently been followed by the Supreme Court of California in *Burtis* v. *Universal Pictures Co. Inc.*, 40 Cal. 2d 823, 835, 256 P. 2d 933 (1953), wherein the Court cited the *Detective Comics* case, *supra*, and the decision by the District Court in the instant case. The District Court here cited the *Detective Comics* and *Nichols* cases (R. 86, 87, 90), the latter also discussed by the Court below.

The above cases, all consonant with the opinion below, do not, however, touch the theory of protection for the use of named characters short of the textual invasion of a copyrighted work. Petitioners' argument that such use

too is protectable under copyright and for the benefit of the copyright owner, or not at all, is refuted by *Fisher* v. *Star Co.*, 231 N. Y. 414, 132 N. E. 133 (1921), *cert. den.*, 257 U. S. 654. In that case, the author and creator of a series of published but uncopyrighted[1] cartoon strips depicting the named characters "Mutt" and "Jeff" enjoined on the ground of unfair competition, a publisher, who had thereafter published and copyrighted other "Mutt" and "Jeff" cartoons by the author, pursuant to an exclusive term contract with him, from publishing after the termination of that agreement "Mutt" and "Jeff" cartoons drawn by another. *Kurlan* v. *Columbia Broadcasting System, Inc.*, 40 Cal. 2d 799, 256 P. 2d 962 (1953) cited by petitioners for the proposition that "after publication * * * characters are not protected by the common law" (Petition, p. 10), is not in point. That case decided by the Supreme Court of California on the same day, April 29, 1953, as the *Burtis* case, *supra*, did not involve the defendant's use of the same named characters of the author. So far as pertinent here, it was decided by virtue of certain local statutory provisions, applicable to the plagiarism claim there presented (Cal. Code, Secs. 980, 983).

The right to the use of the publicized named characters created by an author and identified with him is protected, unless abandoned, under the common law doctrine of unfair competition and vests in the author and his assigns. See *Fisher* v. *Star Co.*, *supra* (pp. 431-433).

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[1] Of the hundreds of "Mutt" and "Jeff" strips by the plaintiff which had preceded the defendant's copyrighted ones, all excepting three copyrighted by the plaintiff had been published without copyright. These three involving only "Mutt" appeared subsequent to the publication without copyright of an initial group of about twenty-five "Mutt" cartoons. The defendant's copyrighted strips numbered approximately two thousand. These facts, conceded in the briefs on appeal (Appellant's Brief, p. 2; Respondent's Brief, pp. 13, 14, 45-47), become apparent from the findings of fact and conclusions of law set out in full preceding the opinion (pp. 415-426, 415, 416). The Court admonishes a reading of these for an understanding of "the true basis of the decision" (p. 428).

In *Atlas Mfg. Co.* v. *Street & Smith*, 204 Fed. 398 (C. C. A. 8, 1913), *app. dism.*, 231 U. S. 348, *cert. den.*, 231 U. S. 755, the suit was by the publisher of a weekly publication entitled "Nick Carter" which contained uncopyrighted stories of a fictional detective by that name. The defendant was a motion picture producer who was about to release a film using that name within its title and for the detective character in the film itself. In denying plaintiff an injunction the court found no competition between the plaintiff's publication and the defendant's motion picture. There was no showing or claim of an assignment of character rights from the author. The latter was not a party to the action.

IV. CONCLUSION

The petitioner seeks the review of an interpretation of a contract between private parties under particular facts unanimously made by all judges in the Courts below. The decision is reasonable and manifestly correct. The so-called copyright ground urged as the basis for review is non-existent since it is at best dictum and moreover does not pose the asserted conflict with the holdings or even theory of cases in the Second Circuit.

The Court should therefore deny the petition for a writ of certiorari.

Respectfully submitted,

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REPLY OF PETITIONERS TO ANSWERS OF RESPONDENTS

The two briefs filed in opposition to the petition demonstrate, we submit, that the issues in this case should be decided by this Court.

1. In neither brief is it disputed that Sam Spade and the other characters of "The Maltese Falcon" are original, well-developed and distinctive. They are characters of the kind which Chief Judge Learned Hand indicated would be, and Circuit Judge Augustus Hand held to be,

protected by the Copyright Act. *Nichols* v. *Universal*, 45 F. 2d 119, 121 (CCA 2, 1930); *Detective Comics* v. *Bruns*, 111 F. 2d 432 (CCA 2, 1940).

2. The brief of Respondents C.B.S. *et al.*, in outright defense of the Court below, sets up as its Point II—**"The character rights are not within the protection of the Copyright Statute"** (C.B.S., p. 8). The comments of Chief Judge L. Hand in the *Nichols* case are passed off as "speculative reflections". The other four character cases cited in the petition (pp. 11-12) are passed off as involving "pictures or cartoons * * * as well as textual matter and literary expressions accompanying the pictures and cartoons" (C.B.S., p. 12). This ignores the fact that the opinion in the *Detective Comics* case applied the same test to the copyrightability of cartoon characters as the *Nichols* case applied to the copyrightability of literary characters.

Circuit Judge A. Hand by his citation of the *Nichols* case in the *Detective Comics* case shows that in his view there is no difference in this regard between a cartoon character and a literary character.[1]

Respondent Hammett, apparently recognizing that there is no distinction between literary and cartoon characters in this regard, is more cautious in his defense of the Court's holding that characters are not protected by copyright. His brief states, p. 7, that the courts "conceive the copyright question as one limited to *textual appropriation*, i.e., whether the expression of pictorial or literary details, including specific incidents or exploits, has been copied". (Emphasis supplied.)

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[1] Incidentally the character protected in the *Detective Comics* case was actually in part cartoon and in part literary. The character "Superman" was delineated by "pictorial representations and verbal descriptions" (*Detective Comics, supra* at 433; petition, p. 11).

When a character in a copyrighted work is original, well-developed, and distinctive, the character is a part of the copyrighted work and has the protection of the copyright. When the *identical character* with the *same characteristics* is *copied* in another work, the subsequent work infringes the copyright. The characters used in the radio series in the present case were the *identical characters,* with the *same characteristics* as those contained in the novel, and they were *copied* from the novel (R. 137-138, 324-325), and the Court so found (R. 90).[2] Therefore it is no answer for Respondent Hammett to say that there was no "textual copying". Furthermore, the law of copyright has long since outgrown such rigid formalized thinking. See petition, p. 12, footnote (6).

3. Respondents' briefs, their Questions Presented and the opinions of the District Court and the Court of Appeals all indicate that their theory of the present case is based on a fundamental, erroneous *assumption:* that there are such things as "character rights" in published works which are not included in the copyright but which exist in the law separately and apart from the Copyright Act; that when a copyright is assigned, these "character rights" are not conveyed because they are not included in the copyright; and that consequently when Warner was granted exclusive dramatic rights (except spoken stage rights) in the novel under copyright, it did not acquire such rights with respect to the characters because "character rights" were not specifically granted. Neither Respondents nor the courts below have cited a single authority to support this emasculation of the Copyright Act.

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[2]Respondent Hammett is inaccurate when he states in his brief, p. 4, "This [radio] series merely used the characters by name".

4. Both Respondents offer the thesis that the author's protection against piracy of his characters lies in the law of unfair competition.

The C.B.S. brief, p. 10, says:

> "Character rights are analogous to trademark rights, and the author may prevent their use by means of unfair competition remedy in the same manner as the use of titles."

The Hammett brief, p. 8, says:

> "The right to the use of the *publicized named* characters created by an author and *identified with him* is protected, unless abandoned, under the common law doctrine of unfair competition and vests in the author and his assigns. See *Fisher* v. *Star Co., supra* (pp. 431-433)." (Emphasis supplied.)

Thus, both briefs claim that the author's right to protection depends upon the establishment in the public mind of a secondary meaning by both publication and publicity (Hammett, p. 8; C.B.S., p. 11).

We submit that Respondents' thesis would work great hardship upon authors whose characters are pirated. They would be deprived of the effective remedies under the Copyright Act in the federal courts. Furthermore, although there has been copying, they would still have to meet, often in the state courts under conflicting state laws, all of the difficult and sometimes vague requirements upon which the remedy of unfair competition is grounded.

Under Respondents' thesis, although "Scarlett O'Hara", and perhaps "Rhett Butler", might be protected, other less publicized, yet flawlessly delineated, characters from "Gone With The Wind" (as well as other works), could be freely appropriated. Moreover, if the

character were taken but with a new name substituted for the original name there would be no protection at all under Respondents' thesis.

Both briefs also ignore the hardship which would be imposed upon the public if copyright protection for original literary characters were abolished and the protection of such characters were limited to the law of unfair competition. According to Respondents, such remedy obtains after publication, even if the work is in the public domain. In support of this proposition they cite *Fisher* v. *Star Co.*, 231 N. Y. 414, 132 N. E. 133 (1921) cert. den. 257 U. S. 654 (Hammett, p. 8; C.B.S., pp. 9, 13). This would mean that after the expiration of the copyright in "The Maltese Falcon," if the public still remembers Sam Spade, Hammett and his heirs could enjoin the use of Spade by others. See petition, p. 10. The effect would be to create a species of perpetual copyright in published works. This result would be contrary to the Copyright Act and the Constitutional provision for protection "for limited times" (Art. 1, §8).

Petitioners have shown that characters in a published work are not protected by unfair competition unless they are also protected by copyright. The cases cited in the petition, p. 10, in support of this rule are ignored by Respondents, except that Respondent Hammett attempts (Hammett, p. 9) to distinguish *Atlas Mfg. Co.* v. *Street & Smith*, 204 Fed. 398 (CCA 8, 1913), cert. den. 231 U. S. 755, while overlooking the primary ground of the Court's decision:

> "Literary property in a book cannot be protected by trade-mark, nor otherwise than by copyright" (204 Fed. 402).

The only case relied upon by Respondents for their thesis to the contrary is *Fisher* v. *Star*. But in that case

the New York state court treated the characters Mutt and Jeff as being under copyright (231 N. Y. at 432-433) and for that reason protected them under principles of unfair competition. This is made additionally clear by the earlier Mutt and Jeff case, *Hill* v. *Whalen & Martell*, 220 Fed. 359 (S.D.N.Y., 1914), where an injunction was issued under the Copyright Act enjoining the piracy of these characters.

5. There is a final point on which Respondents differ. C.B.S. recognizes that the Court below *held* that (in C.B.S.'s words) "the copyright alone does not protect character rights." C.B.S., p. 5. Hammmett contends that this part of the Court's opinion is *obiter*. Hammett, p. 6. We submit that C.B.S. is right on this point. See petition, pp. 7, 8.

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